

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

*Agency*  
*Nagano* *Yohannan*  
SOLICITOR  
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U.S. PATENT & TRADEMARK OFFICE  
#12

ELF-ATOCHEM NORTH AMERICA, INC., )

Plaintiff )

v. )

Civil Action No. 99-2559 (TPJ)

Q. TODD DICKINSON, )  
Assistant Secretary of Commerce )  
and Commissioner of Patents and )  
Trademarks, )

Defendant. )  
\_\_\_\_\_ )

**DEFENDANT'S MOTION FOR SUMMARY JUDGMENT**

Defendant moves for summary judgment disposing of this action pursuant to Fed. R. Civ.


P. 56. In support of this Motion, defendant refers the Court to the accompanying Memorandum of Points and Authorities and Statement of Material Facts As To Which There Is No Genuine Dispute. A proposed Order is attached.

Defendant requests oral argument on this motion.

Respectfully submitted,

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**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

ELF-ATOCHEM NORTH AMERICA, INC.,

Plaintiff

v.

Q. TODD DICKINSON,  
Assistant Secretary of Commerce  
and Commissioner of Patents and  
Trademarks,

Defendant.

Civil Action No. 99-2559 (TPJ)

**STATEMENT OF MATERIAL FACTS  
AS TO WHICH THERE IS NO GENUINE DISPUTE**

**A. The Claimed Composition**

1. Plaintiff Elf-Atochem North America, Inc.'s ("Atochem's") claimed composition is a "stabilizer" used to make polyvinyl chloride, or PVC (a plastic material commonly used for making pipes for use in plumbing), that is stronger, whiter, and more resistant to heat and light.

Ex. 2 at 5.

2. Atochem filed its first patent application describing the claimed composition in 1979. Compl. ¶ 7.

3. Atochem filed the application at issue in this case, U.S. Patent Application No. 07/870,759 ("the '759 application"), in 1992. Compl. ¶ 5.

4. The '759 application is the fifth in the series. Compl. ¶ 7.

5. The '759 application contains more than 100 pending claims to permutations of the claimed composition: claims 176-83, 193-98, 200-07, 209-17, 219-25, 227-33, and 237-323.

Compl. ¶ 9.

6. However, Atochem did not ask the Board to separately consider each claim, but instead submitted the claims in two groups, of which it treated claims 247 and 296 as representative. Ex. 1 at 3.

7. Both claims 247 and 296 recite "a composition comprising a product produced by mixing" two chemicals "in amounts effective to stabilize vinyl halide resins" such as PVC. Ex. 1 at 2.

8. The two chemicals recited in claim 247 are "a mono- or diorganotin compound wherein at least one atom bonded to tin is sulfur"; and "a mercapto alkanol ester of a monocarboxylic acid." Id. (For ease of reference, this statement refers to these chemicals as "Compound A" and "Compound B" respectively wherever possible.)

9. The only difference between claim 247 and claim 296 is replacement of the word "sulfur" in the description of Compound A with the phrase "a halogen." See Ex. 1 at 2.

10. Thus, the two chemicals recited in claim 296 are "a mono- or diorganotin compound wherein at least one atom bonded to tin is a halogen" -- referred to in this memorandum as "Compound A' (A-prime)"-- and Compound B. Id.

#### **B. The PTO's Determinations**

11. The examiner rejected all of Atochem's claims as, among other things, obvious over the prior art Gough patent ("Gough") (Ex. 3) read in view of the Stapfer (Ex. 4), Hechenbleikner '527 (Ex. 5), Hechenbleikner '129 (Ex. 6), Wowk (Ex. 9), Schroeder (Ex. 10), Weinberg (Ex. 7), and Kauder (Ex. 8) patents ("the secondary references"). Ex. 1 at 5.

12. Atochem then appealed to the Board. See Ex. 11.

13. In its February 23, 1999 decision, the Board reversed the examiner on some grounds, but the Board affirmed the obviousness rejection. Ex. 1 at 16.

14. The Board first focused on Compound B, the "mercapto alkanol ester of a monocarboxylic acid." Ex. 1 at 13.

15. The Board noted Atochem's admission that Gough (Ex. 3) discloses the use of Compound B (a "mercapto alkanol ester of a monocarboxylic acid") within the scope of the claims. Ex. 1 at 13.

16. The Board also found that Atochem admitted that Gough disclosed Compound B in conjunction with an "organotin borate" compound which belongs to the same class of compounds as Compounds A and A', the "mono- or diorganic compound[s] wherein at least one atom bonded to tin is" sulfur (Compound A, claim 247) or a halogen (Compound A', claim 296). Ex. 1 at 13.

17. Therefore, the Board reasoned that Gough discloses what Atochem claims as its discovery, that is, "that a different additive -- with its sulfur atom bonded not at the acid part of the monocarboxylic acid but at the alcohol part of that compound [Compound B] -- dramatically improved the performance of tin stabilizers used for stabilizers polymers." Ex. 1 at 13.

18. The Board recognized that Gough does not teach the claimed organotin compounds, Compounds A and A', included in the claimed composition. Ex. 1 at 13.

19. The Board found, however, that the secondary references teach the use of Compounds A and A' as stabilizers for PVC. Ex. 1 at 13.

20. In its appeal brief to the Board, Atochem stated that "appellants [the named inventors who assigned the application to Atochem] always maintained that the organotin compounds used in the claimed invention were well known in the art." Ex. 11 at 30.

21. The "organotin compounds" in claims 247 and 296 are Compounds A and A'. See Ex. 1 at 2.

22. In reaching its determination, the Board rejected Atochem's contention that there would have been no motivation for one of ordinary skill in the art to substitute the claimed, conventional organotin compounds (Compounds A and A') for the organotin borates of Gough. Ex. 1 at 14.

23. Instead, the Board found that one of ordinary skill in the art would have understood from Gough not only that the particular synergistic combinations of Gough are superior to other known combinations of stabilizers but also that other combinations of organotin compounds (such as Compounds A and A') and a mercapto alkanol ester of a monocarboxylic acid (Compound B) are effective, if not equivalent, stabilizers for PVC. Ex. 1 at 14-15. In other words, other organotin compounds such as Atochem's Compound A or A' would be as effective in combination with Gough's Compound B as was Gough's own organotin borate.

24. The Board also found that the prior art Stapfer patent (Ex. 4) teaches that a combination of an organotin compound where at least one bond to tin is sulfur (Compound A) and an organic sulfur compound (generally Compound B) provides a synergistic stabilization for PVC. Ex. 1 at 14.

25. Thus, Stapfer also provides a motivation to combine. Ex. 1 at 14.

26. The Board specifically noted that Atochem admitted that “[t]he prior art supports [Atochem’s] position that organotin halides were well known conventional compounds which would fall within the scope of [Atochem’s] claims.” Ex. 1 at 15.

27. From this, the Board concluded that because absolute predictability is not required for finding obviousness, one of ordinary skill in the art would have had a reasonable expectation of successfully stabilizing PVC with a combination of Atochem’s mercapto alkanol ester of a monocarboxylic acid (Compound B), which is specifically disclosed by Gough, and a conventional organotin stabilizer (such as Compounds A and A’), which is well known in the art. Ex. 1 at 15.

28. Therefore the Board affirmed the examiner’s conclusion that the appealed claims are prima facie obvious over the prior art. Id.

29. Atochem submitted a declaration executed by Michel Foure in 1982 (Ex. 14) in an effort to overcome the PTO’s prima facie case of obviousness. See Ex. 1 at 15.

30. The Board afforded little weight to this evidence because Atochem did not meet its burden of explaining the content and significance of the declaration data. Ex. 1 at 15.

31. The Board stated that Atochem devoted a “scant two sentences to the merits of the Rule 132 Declaration.” Ex. 1 at 15.

32. The only “explanation” Atochem gave of the evidence was to state that the declaration provides “a number of comparisons of compositions of the present invention with those of Gough and Stapfer. There is more than a single comparison.” Ex. 11 at 35.

33. The Board found that this conclusory statement fell far short of Atochem’s burden explaining the content and significance of the declaration data. Ex. 1 at 15-16.

34. Further, the Board held that the declaration does not provide a comparison of the closest prior art. Ex. 1 at 15-16.

35. In particular, the declaration failed to compare stabilizer compositions within the scope of the claims of the '759 application and those of Gough comprising Atochem's mercapto alkanol ester (Compound B) and an organotin borate. Ex. 1 at 15-16.

36. Finally, the Board held that the probative value of the declaration data was not commensurate with the scope of the degree of protection sought by the claims. Ex. 1 at 16.

37. Consequently, the Board viewed the declaration evidence as insufficient to factually establish that the broadly recited halogen-containing and sulfur-containing organotin stabilizers (Compounds A and A'), as a class, in a mixture with the broadly recited mercapto alkanol ester of a monocarboxylic acid (Compound B), as a class, are unexpectedly superior to the class of synergistic combinations disclosed by Gough and the prior art. Ex. 1 at 16.

38. Unsatisfied with the Board's opinion, Atochem asked for reconsideration. Ex. 12.

39. In its July 27, 1999 reconsideration decision, the Board reaffirmed its holding that the examiner had established a prima facie case of obviousness. Ex. 13 at 2.

40. The Board reiterated that Gough discloses that it was known in the art to use organic sulfur compounds (Compound B) and organotin compounds (generally Compound A, claim 247) to inhibit or prevent discoloration of PVC. Ex. 13 at 2-3.

41. Additionally, the Board observed that Stapfer discloses that a combination of organotin mercaptides (Compound A, claim 247) and organic sulfur compounds (such as Compound B: the word "mercapto" in the description of Compound B refers to sulfur, see



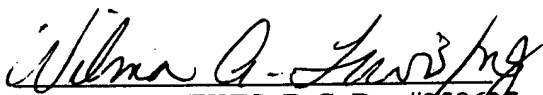
Hawley's Condensed Chem. Dictionary at 740 (11th ed. 1987)) produces synergistic results in stabilizing PVC. Ex. 13 at 3.

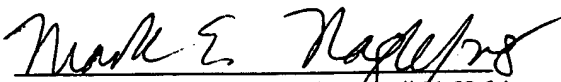
42. The Board concluded it had not erred when it held that one of ordinary skill in the art would have had a reasonable expectation of obtaining a synergistic effect when utilizing Gough's organic sulfur compounds (Compound B) and Stapfer's organotin mercaptides (Compound A) as stabilizers for PVC. Ex. 13 at 3-4.


43. The Board further elaborated that Wowk (Ex. 9) and Schroeder (Ex. 10) specifically teach the stabilization of PVC with an organotin compound where at least one bond to tin is a halogen (Compound A', claim 296). Ex. 13 at 3.

44. Schroeder also teaches that such a compound can be combined with other known stabilizers including organic sulfur-containing compounds (such as Compound B). Ex. 10, col. 2, lines 18-26.

Respectfully submitted,

  
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**MARK NAGUMO**

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Civil Action No. 99-2559 (TPJ)

**MEMORANDUM IN SUPPORT OF DEFENDANT'S  
MOTION FOR SUMMARY JUDGMENT**

Plaintiff Elf-Atochem North America, Inc. ("Atochem") challenges the Patent and Trademark Office's ("PTO's") decision not to award Atochem a patent on certain chemical compositions ("the claimed composition[s]"). The claimed compositions are mixtures of compounds which were known before Atochem made and applied for a patent on the claimed compositions. The PTO's Board of Patent Appeals and Interferences ("Board") determined that a person of ordinary skill in the art would have been motivated to combine the known compounds to make the claimed compositions, and therefore that the claimed compositions would have been obvious. Obvious compositions are not patentable. 35 U.S.C. § 103(a).

Atochem contends that the Board erred in making its determination. Compl. ¶ 13. As set forth more fully below, however, Atochem cannot survive the present motion for summary judgment. The administrative record supports the Board's factual finding that a person of ordinary skill would have been motivated to combine the two previously known types of chemicals to create the claimed composition. The record also supports the Board's factual

determination that a declaration Atochem submitted did not provide evidence of the unexpected superiority of Atochem's claimed composition over the closest, most relevant, prior art, and therefore the declaration was not sufficient to support patentability. The Board did not err in concluding that the claimed composition would have been obvious.

The issues outlined above could be addressed in a direct appeal to the U.S. Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. § 141. Atochem has chosen, however, to pursue an intermediate appeal to this Court pursuant to 35 U.S.C. § 145, because Atochem seeks to present new evidence to this Court which it did not present to the PTO for administrative review. An applicant ordinarily presents new evidence to the PTO first, for example by filing a new patent application and then presenting the evidence to the PTO examiner assigned to review that application. Atochem recognizes this fact, and indeed Atochem's present application is only the latest in a series that stretches back to 1979. Compl. ¶ 7. But Atochem contends that it cannot now file yet another application and therefore should be entitled to present the new evidence to this Court without prior PTO review. Compl. ¶ 14. Atochem points to a new statutory limit on patent duration which Congress enacted in 1995, while Atochem's case was pending before the Board. The statute in effect before 1995 set the patent term at 17 years from issuance of the patent. On June 8, 1995, however, Congress enacted a statute setting the patent term for applications filed after that date at 20 years from the filing date of the first patent application in the series. 35 U.S.C. § 154(a)(2). Accordingly, there is no point in Atochem's filing a new application now, more than 20 years after it filed its first application.

Again, however, as explained more fully below, Atochem cannot survive the present motion for summary judgment. The 1995 statutory change does not excuse Atochem's failure to

obtain administrative review of its new evidence. Atochem had the entire period from 1979 to 1995 to develop evidence and present it to the PTO. Moreover, Atochem was not required to wait for the Board's decision to file a new patent application, and in fact Atochem did file a new application just before the law changed in 1995. Atochem could have used that application as a vehicle to present new evidence, but Atochem abandoned it instead. Atochem could also have petitioned to have any new evidence considered with respect to the present application. But Atochem did not even try. Atochem should not be allowed to present new evidence to this Court for initial review when Atochem had ample opportunity to present it to the PTO.

## **I. STATUTORY AND REGULATORY BACKGROUND**

Defendant Q. Todd Dickinson ("the Commissioner") is the government official authorized to direct examination of patent applications. 35 U.S.C. § 131. Under the Commissioner's direction, patent examiners, who are technical and scientific specialists, assess whether claimed inventions are patentable. An applicant dissatisfied with the examiner's final decision may make an administrative appeal to the Board. 35 U.S.C. § 134. The applicant may appeal the Board's decision to the Federal Circuit or to this Court. 35 U.S.C. §§ 141, 145.

Patent applications are filed in the name of the individual or individuals who allegedly made the claimed invention, not their employer. 35 U.S.C. § 116. Thus, Atochem filed the application at issue in this case in the names of Jean-Yves Chenard and Jean-Claude Mendelsohn. Compl. ¶ 6. The application is assigned to Atochem, however, and Atochem filed the present action in its own name. Compl. ¶ 5.

A patent application must contain a specification which includes one or more patent claims. 35 U.S.C. § 111. The claims define the particular invention for which the applicant seeks

patent rights. In re Vamco Mach. & Tool, Inc., 752 F.2d 1564, 1577 n.5 (Fed. Cir. 1985) (one function of the claims is "to define the scope of protection afforded by the patent").

The examiner reviews the claims to determine whether they meet the statutory criteria for patentability in 35 U.S.C. §§ 101-103 and 112, including the criterion that they must claim nonobvious subject matter in § 103(a). A claimed invention is unpatentable as obvious "if the differences between the subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). The "prior art" is defined by the criteria in 35 U.S.C. § 102, and includes, among other things, all of the information that would have been available to persons of ordinary skill prior to the making of the claimed invention.

An applicant for a patent is free to submit evidence of patentability to the examiner. The applicant may include evidence in the patent application itself. If the examiner determines to reject a claim, the applicant may also present evidence to challenge the rejection. 37 C.F.R. § 1.111.

An applicant for a patent is also free to submit additional applications directed to the same subject matter at any time and for any reason. Such applications which meet the criteria of 35 U.S.C. § 120 are entitled to the benefit of the filing date of the original application.

## **II. FACTUAL BACKGROUND**

### **A. The Claimed Composition**

The claimed composition is a "stabilizer" used to make polyvinyl chloride, or PVC (a plastic material commonly used for making pipes for use in plumbing), that is stronger, whiter, and more resistant to heat and light. Ex. 2 at 5.

Atochem filed its first patent application describing the claimed composition in 1979. Compl. ¶ 7. Atochem filed the application at issue in this case, U.S. Patent Application No. 07/870,759 ("the '759 application"), in 1992. Compl. ¶ 5. The '759 application is the fifth in the series. Compl. ¶ 7.

The '759 application contains more than 100 pending claims to permutations of the claimed composition: claims 176-83, 193-98, 200-07, 209-17, 219-25, 227-33, and 237-323. Compl. ¶ 9. However, Atochem did not ask the Board to separately consider each claim, but instead submitted the claims in two groups, of which it treated claims 247 and 296 as representative. Ex. 1 at 3.

Both claims 247 and 296 recite "a composition comprising a product produced by mixing" two chemicals "in amounts effective to stabilize vinyl halide resins" such as PVC. Ex. 1 at 2. The two chemicals recited in claim 247 are "a mono- or diorganotin compound wherein at least one atom bonded to tin is sulfur"; and "a mercapto alkanol ester of a monocarboxylic acid." Id. (For ease of reference, this memorandum refers to these chemicals as "Compound A" and "Compound B" respectively wherever possible.)

The only difference between claim 247 and claim 296 is replacement of the word "sulfur" in the description of Compound A with the phrase "a halogen." See Ex. 1 at 2. Thus, the two chemicals recited in claim 296 are "a mono- or diorganotin compound wherein at least one atom bonded to tin is a halogen" -- referred to in this memorandum as "Compound A' (A-prime)"-- and Compound B. Id.

## **B. The PTO's Determinations**

The examiner rejected all of Atochem's claims as, among other things, obvious over the prior art Gough patent ("Gough") (Ex. 3) read in view of the Stapfer (Ex. 4), Hechenbleikner '527 (Ex. 5), Hechenbleikner '129 (Ex. 6), Wowk (Ex. 9), Schroeder (Ex. 10), Weinberg (Ex. 7), and Kauder (Ex. 8) patents ("the secondary references"). Ex. 1 at 5.

Atochem then appealed to the Board. See Ex. 11. In its February 23, 1999 decision, the Board reversed the examiner on some grounds, but the Board affirmed the obviousness rejection. Ex. 1 at 16. The Board first focused on Compound B, the "mercapto alkanol ester of a monocarboxylic acid." Ex. 1 at 13. The Board noted Atochem's admission that Gough (Ex. 3) discloses the use of Compound B (a "mercapto alkanol ester of a monocarboxylic acid") within the scope of the claims. Ex. 1 at 13. The Board also found that Atochem admitted that Gough disclosed Compound B in conjunction with an "organotin borate" compound which belongs to the same class of compounds as Compounds A and A', the "mono- or diorganic compound[s] wherein at least one atom bonded to tin is" sulfur (Compound A, claim 247) or a halogen (Compound A', claim 296). Ex. 1 at 13. Therefore, the Board reasoned that Gough discloses what Atochem claims as its discovery, that is, "that a different additive -- with its sulfur atom bonded not at the acid part of the monocarboxylic acid but at the alcohol part of that compound [Compound B] -- dramatically improved the performance of tin stabilizers used for stabilizers polymers." Ex. 1 at 13.

The Board recognized that Gough does not teach the claimed organotin compounds, Compounds A and A', included in the claimed composition. Ex. 1 at 13. The Board found, however, that the secondary references teach the use of Compounds A and A' as stabilizers for



PVC. Ex. 1 at 13. In its appeal brief to the Board, Atochem stated that "appellants [the named inventors who assigned the application to Atochem] always maintained that the organotin compounds used in the claimed invention were well known in the art." Ex. 11 at 30. The "organotin compounds" in claims 247 and 296 are Compounds A and A'. See Ex. 1 at 2.

In reaching its determination, the Board rejected Atochem's contention that there would have been no motivation for one of ordinary skill in the art to substitute the claimed, conventional organotin compounds (Compounds A and A') for the organotin borates of Gough. Ex. 1 at 14. Instead, the Board found that one of ordinary skill in the art would have understood from Gough not only that the particular synergistic combinations of Gough are superior to other known combinations of stabilizers but also that other combinations of organotin compounds (such as Compounds A and A') and a mercapto alkanol ester of a monocarboxylic acid (Compound B) are effective, if not equivalent, stabilizers for PVC. Ex. 1 at 14-15. In other words, other organotin compounds such as Atochem's Compound A or A' would be as effective in combination with Gough's Compound B as was Gough's own organotin borate.

The Board also found that the prior art Stapfer patent (Ex. 4) teaches that a combination of an organotin compound where at least one bond to tin is sulfur (Compound A) and an organic sulfur compound (generally Compound B) provides a synergistic stabilization for PVC. Ex. 1 at 14. Thus, Stapfer also provides a motivation to combine. Ex. 1 at 14.

The Board specifically noted that Atochem admitted that "[t]he prior art supports [Atochem's] position that organotin halides were well known conventional compounds which would fall within the scope of [Atochem's] claims." Ex. 1 at 15. From this, the Board concluded that because absolute predictability is not required for finding obviousness, one of ordinary skill in

the art would have had a reasonable expectation of successfully stabilizing PVC with a combination of Atochem's mercapto alkanol ester of a monocarboxylic acid (Compound B), which is specifically disclosed by Gough, and a conventional organotin stabilizer (such as Compounds A and A'), which is well known in the art. (Def. Ex. 1 at 15.) Therefore the Board affirmed the examiner's conclusion that the appealed claims are prima facie obvious over the prior art. Id.

Atochem submitted a declaration executed by Michel Foure in 1982 (Ex. 14) in an effort to overcome the PTO's prima facie case of obviousness. See Ex. 1 at 15. The Board afforded little weight to this evidence because Atochem did not meet its burden of explaining the content and significance of the declaration data. (Def. Ex. 1 at 15.) The Board stated that Atochem devoted a "scant two sentences to the merits of the Rule 132 Declaration." (Def. Ex. 1 at 15.) The only "explanation" Atochem gave of the evidence was to state that the declaration provides "a number of comparisons of compositions of the present invention with those of Gough and Stapfer. There is more than a single comparison." Ex. 11 at 35. The Board found that this conclusory statement fell far short of Atochem's burden explaining the content and significance of the declaration data. Ex. 1 at 15-16.

Further, the Board held that the declaration does not provide a comparison of the closest prior art. Ex. 1 at 15-16. In particular, the declaration failed to compare stabilizer compositions within the scope of the claims of the '759 application and those of Gough comprising Atochem's mercapto alkanol ester (Compound B) and an organotin borate. Ex. 1 at 15-16. Finally, the Board held that the probative value of the declaration data was not commensurate with the scope of the degree of protection sought by the claims. Ex. 1 at 16. Consequently, the Board viewed

the declaration evidence as insufficient to factually establish that the broadly recited halogen-containing and sulfur-containing organotin stabilizers (Compounds A and A'), as a class, in a mixture with the broadly recited mercapto alkanol ester of a monocarboxylic acid (Compound B), as a class, are unexpectedly superior to the class of synergistic combinations disclosed by Gough and the prior art. Ex. 1 at 16.

Unsatisfied with the Board's opinion, Atochem asked for reconsideration. Ex. 12. In its July 27, 1999 reconsideration decision, the Board reaffirmed its holding that the examiner had established a prima facie case of obviousness. Ex. 13 at 2. The Board reiterated that Gough discloses that it was known in the art to use organic sulfur compounds (Compound B) and organotin compounds (generally Compound A, claim 247) to inhibit or prevent discoloration of PVC. Ex. 13 at 2-3. Additionally, the Board observed that Stapfer discloses that a combination of organotin mercaptides (Compound A, claim 247) and organic sulfur compounds (such as Compound B: the word "mercapto" in the description of Compound B refers to sulfur, see Hawley's Condensed Chem. Dictionary at 740 (11th ed. 1987)) produces synergistic results in stabilizing PVC. Ex. 13 at 3. The Board concluded it had not erred when it held that one of ordinary skill in the art would have had a reasonable expectation of obtaining a synergistic effect when utilizing Gough's organic sulfur compounds (Compound B) and Stapfer's organotin mercaptides (Compound A) as stabilizers for PVC. Ex. 13 at 3-4. The Board further elaborated that Wowk (Ex. 9) and Schroeder (Ex. 10) specifically teach the stabilization of PVC with an organotin compound where at least one bond to tin is a halogen (Compound A', claim 296). Ex. 13 at 3. Schroeder also teaches that such a compound can be combined with other known

stabilizers including organic sulfur-containing compounds (such as Compound B). Ex. 10, col. 2, lines 18-26.

### III. SUMMARY JUDGMENT STANDARD

Federal Rule of Civil Procedure 56(c) provides that a court may grant summary judgment if “there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” The moving party bears the burden of proving that there is no genuine issue of material fact and that it is entitled to judgment. See, e.g., Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). Once the moving party has satisfied its burden of showing a lack of any genuine issue of material fact, the nonmoving party must present evidence that shows that a genuine issue of material fact exists. Avia Group v. L.A. Gear, 853 F.2d 1557, 1560 (Fed. Cir. 1988). Mere denials or conclusory statements are insufficient to create a genuine issue of material fact. See, e.g., Barmag Barmer AG v. Murata Mach., 731 F.2d 831, 836 (Fed. Cir. 1984). In addition, if the nonmoving party’s evidence is not significantly probative, summary judgment may be granted. See, e.g., Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586-87 (1986).

It is well settled that summary judgment is appropriate in patent cases. SRI International v. Matsushita Elec. Corp., 775 F.2d 1107 (Fed. Cir. 1985) (in banc). In particular, summary judgment is appropriate for questions involving obviousness. See, e.g., Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 719-20 (Fed. Cir. 1991) (affirming grant of summary judgment that patent claims would have been obvious). On summary judgment in determining whether plaintiff has raised a genuine dispute as to any material facts, the Court must determine whether a reasonable finder of fact could find for plaintiff under the unsupported by substantial evidence

standard that controls in 35 U.S.C. § 145. See Gallagher v. Quigg, 8 USPQ2d 1437, 1438 (D.D.C. 1988) (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 254-55 (1986)) (applying clear error standard of review); In re Gartside, \_\_\_ F.3d \_\_\_, No. 99-1241, 2000 WL 156565, at \*8 (Fed. Cir. Feb. 15, 2000) (attached as Ex. 17) (adopting substantial evidence standard of review).

#### **IV. THE RECORD SUPPORTS THE BOARD'S OBVIOUSNESS DETERMINATION**

##### **A. Standard of Review**

Section 145 of the Patent Act allows patent applicants to bring suit to set aside a final decision of the Board. 35 U.S.C. § 145; Fregeau v. Mossinghoff, 776 F.2d 1034, 1036-37 (Fed. Cir. 1985). Atochem brings this case to overturn the Board's February 23, 1999 decision, and its July 27, 1999 decision on reconsideration, which held that all claims remaining in the '759 application are obvious under 35 U.S.C. § 103. Ex. 1 at 16; Ex. 13 at 1-2.

Obviousness – the only issue in this case – is a legal conclusion, reviewed de novo. In re Rouffett, 149 F.3d 1350, 1355 (Fed. Cir. 1998); In re Beattie, 974 F.2d 1309, 1311 (Fed. Cir. 1992); In re Woodruff, 919 F.2d 1575, 1577 (Fed. Cir. 1990). The legal conclusion of obviousness, however, is based on underlying factual findings. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); Markman v. Lehman, 987 F. Supp. 25, 29 (D.D.C. 1997); In re Van Geuns, 988 F.2d 1181, 1185 (Fed. Cir. 1993); Beattie, 974 F.2d at 1311. The Federal Circuit (which has exclusive appellate jurisdiction in this case, 28 U.S.C. § 1295) recently held that the Board's factual determinations in an obviousness analysis must be upheld unless they are unsupported by substantial evidence. Gartside, 2000 WL 156565, at \*8.

Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229 (1938). "[A] possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." Consolo v. Federal Maritime Comm'n, 383 U.S. 607, 620 (1966).

**B. The Board's Factual Findings Are Supported by Substantial Evidence**

While obviousness is a question of law, it rests on four questions of fact: (i) the scope and content of the prior art; (ii) the level of skill in the art; (iii) the differences between the prior art and the claims; and (iv) the import of any objective evidence of nonobviousness. Graham, 383 U.S. at 17-18; Van Geuns, 988 F.2d at 1185. Because the Board's factual findings are entirely supported by substantial evidence, they should be affirmed and adopted by this Court.

**1. The Scope and Content of the Prior Art**

The teachings of the prior art references (the patents attached as Exs. 3-10), their relation to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention are all relevant considerations. See In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992); In re Gorman, 933 F.2d 982, 986-87 (Fed. Cir. 1991). In determining the scope and content of the prior art, the prior art is relevant for all it contains, including what it fairly suggests to one of ordinary skill in the art. In re Young, 927 F.2d 588, 591 (Fed. Cir. 1991).

The Board relied on Gough and the secondary references (Stapfer, Hechenbleikner '527, Hechenbleikner '129, Wowk, Schroeder, Weinberg, and Kauder) to reject all of Atochem's claims under § 103. Ex. 1 at 13; Ex. 13 at 2. All of these prior art references are directed to the

stabilization of PVC using an organotin compound either alone or in combination with something else. Ex. 3 at col. 1, lines 7-14 (1:7-14); Ex. 4 at 1:17-20 and 11:5-33; Ex. 5 at 1:11-13 and 2:27-40; Ex. 6 at 1:14-27; Ex. 7 at 1:14-37; Ex. 8 at 1:16-25; Ex. 9 at 1:6-8; Ex. 10 at 1:18-23.

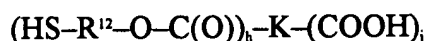
Compounds A and A' are examples of organotin compounds. See Ex. 1 at 2. These references therefore solve the same problem addressed in the '759 application. Consequently, these references are "analogous" prior art, that is, they are in the field of the inventor's endeavor or are reasonably pertinent to the particular problem with which the inventor was involved. See In re Clay, 966 F.2d 656, 658 (Fed. Cir. 1992); In re Wood, 599 F.2d 1032, 1036 (CCPA 1979).

When the "references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed . . . and the test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." Gorman, 933 F.2d at 986.

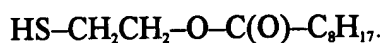
The Board's findings as to the scope and content of the prior art are supported by substantial evidence and are based on an accurate reading of that art. The prior art references are discussed below.

**a. Gough's Teaching of Compound B**

Gough (Ex. 3) discloses stabilizer compositions for PVC that are a mixture of an organotin compound, specifically an organotin borate (which is similar to the organotin Compounds A and A'), and an organic sulfur compound *i.e.*, a mercapto alkanol ester of a monocarboxylic acid (Compound B). Ex. 3 at 1:5-19. Particularly relevant to this case is Gough's compound (g), which has the structure:



where 1)  $R^{12}$  is 1-20 carbon chain of some form that links the HS- and OC(O) parts; 2) K is a linking group; 3) h is 1 to 4; and 4) j is 0 to 3. Ex. 3 at 8:44; definitions at 5:16-26. When  $h = 1$  and  $j = 0$ , this formula describes the exact mercapto alkanol ester of a monocarboxylic acid, or Chemical B, as required by Atochem's claims 247 and 296. Id.; see Ex. 11 at 30 (discussing Gough's compound (g)). Gough also discloses a specific example of such a compound, 2-thioethyl octanoate,



Ex. 3 at 8:64. This 2-thioethyl octanoate compound falls directly in the scope of the Compound B recited in claims 247 and 296.

The other part of the claimed composition, Compound A and A', Atochem has already admitted was well-known in the art. Ex. 11 at 30 ("Appellants always maintained that the organotin compounds used in the claimed invention [Compounds A and A'] were well known in the art."). Thus, all that needs to be shown is the motivation to combine Gough with this well-known art. In sum, the only difference between Gough and the claimed subject matter is that the organotin compound Gough teaches in combination with Compound B is not the organotin compound that has at least one atom of sulfur bonded to tin (Compound A) recited in claim 247, or the organotin compound that has at least one halogen atom bonded to tin (Compound A') recited in claim 296, but instead is an organotin borate. Ex. 3 at 2:7. However, the remaining references do teach organotin Compounds A and A' as stabilizers for PVC.



**b. The Teaching in the Secondary References of Compounds A and A'**

The secondary references all disclose organotin compounds where tin is bonded to sulfur, that is, Compound A. Additionally, Wowk and Schroeder disclose organotin compounds where tin is bonded to a halogen, that is, Compound A'.

**The Sulfur-Containing Organotin Compounds (Compound A, Claim 247)**

**Stapfer**

Stapfer (Ex. 4) is directed to the stabilization of PVC using conventional stabilizers combined with silicates. Ex. 4 at 1:18-23. Stapfer discloses an exhaustive list of organotin compounds that can be used to stabilize PVC. Ex. 4 at 3:20 - 11:75. Specifically, Stapfer teaches that the very organotin compound that Atochem is attempting to patent in claim 247, Compound A, can be used to stabilize PVC. Ex. 4 at 11:4-32 (listing numerous examples of Compound A). Stapfer also discusses thiocarboxylates, which are organic compounds containing sulfur in the same class as Compound B. Ex. 4 at 11:34-61. In sum, Stapfer directly discloses that Compound A for claim 247 and a compound similar to Compound B may be combined to form a PVC stabilizer.

Further, Stapfer provides another important link in the obviousness analysis, the motivation to combine Stapfer (which discloses Compound A) and Gough (which discloses Compound B). Stapfer states “[w]hile many of the compounds listed are poor stabilizers alone, they may be used in combinations which exhibit synergism that are further improved by the present invention.” Ex. 4 at 3:16-19. In other words, the listed classes of stabilizer compounds

may be combined with one another to make a superior stabilizer composition. This is exactly what Atochem is attempting to patent.

### **Hechenbleikner '527**

Hechenbleikner '527 (Ex. 5) discloses stabilizers for PVC that comprise synergistic combinations of organotin compounds and certain organic sulfur compounds that do not contain tin. Ex. 5 at 1:11-37. The organotin compounds are characterized as acceptors for hydrogen chloride, and therefore stabilizers for PVC. Ex. 5 at 2:65-67. A wide range of organotin compounds are disclosed to be useful components of the inventive stabilizer. Ex. 5 at 2:27-39. Specifically, Hechenbleikner '527 teaches organotin compounds where at least one bond to tin is sulfur,  $R_2SnS$ , that is, Compound A. Ex. 5 at 2:27-39. Hechenbleikner '527 gives illustrations of such compounds, for example dibutyl tin sulfide. Ex. 5 at 2:46. Certain compounds that contain sulfur are disclosed to be particularly useful as synergists in combination with the organotin compounds (Compound A) as stabilizers for PVC. Ex. 5 at 2:68 - 4:9. Thus, Hechenbleikner '527 provides further motivation to combine Compound A with an organic sulfur compound to get a superior PVC stabilizer. Compound B is an organic sulfur compound. See Ex. 1 at 2 (Compound B is a "mercapto alkanol ester of a monocarboxylic acid"); Hawley's Condensed Chem. Dictionary at 740 (11th ed. 1987) ("mercapto" refers to sulfur). Therefore, Hechenbleikner '527 provides motivation to combine its disclosed Compound A with Gough's Compound B.

### **Kauder**

Kauder (Ex. 8) is directed to the use of organotin compounds to stabilize PVC. Ex. 8 at 1:15-25. In particular, Kauder's stabilizing composition includes at least one organotin

compound where at least one bond to tin is sulfur (Compound A). Ex. 8 at 1:34-38, 54-55 (disclosing organotin mercapto carboxylic acid esters, an example of Compound A). Kauder states that “[t]he stabilizing effectiveness of organotin stabilizers for poly vinyl chloride resins is generally associated with organotin groups, tin content, and to some degree sulfur content.” Ex. 8 at 1:39-42. Therefore, Kauder recognized that organotin stabilizers containing sulfur (Compound A) were more generally effective PVC stabilizers.

### **Weinberg**

Weinberg (Ex. 7) discloses organotin derivatives of sulfur containing compounds. Ex. 7 at 1:17-20. Weinberg found that his organotin compounds, where tin is bonded to sulfur (that is, Compound A), are far superior to conventional PVC stabilizers. Ex. 7 at 1:38-50, 53-56. Weinberg’s disclosed organotin compounds also read directly upon Compound A of claim 247. Ex. 7 at 1:27-30; 13:claims 1 and 2 (disclosing examples of Compound A).

### **(ii) The Halogen-Containing Organotin Compounds (Compound A’, Claim 296)**

### **Schroeder**

Schroeder (Ex. 10) discloses that stabilizers for PVC include organotin compounds that include a sulfur-to-tin bond. Ex. 10 at col. 1, lines 40-45. Schroeder’s contribution to the art is an improved organotin stabilizer for PVC that has a halogen bonded to the tin, that is, Compound A’. Ex. 10 at 1:65-70. The halogen compound that Schroeder teaches is bonded to the tin is flouride. Ex. 10 at 1:65-70. Therefore, Schroeder specifically teaches Compound A’ of claim 296. Additionally, Schroeder describes organotin stabilizers where tin is bonded to sulfur (which is Compound A, claim 247). Ex. 10 at 1:65-70. Such stabilizers, according to Schroeder, may be

combined with other known organo-tin stabilizers (Ex. 10 at 2:18-41), as well as with other ingredients such as antioxidants and ultraviolet absorbers. Ex. 10 at 2:42-49.

### **Wowk**

Wowk (Ex. 9) also discloses PVC stabilizers that are organotin halide compositions such as Compound A'. Ex. 9 at 1:45 (diagram). Wowk teaches organotin compounds where the tin is bonded directly to a halogen. Id. Thus, Wowk specifically teaches Compound A' of claim 296. The halogens can be chlorine, bromine, or iodide. Ex. 9 at 2:10-11. Additionally, Wowk describes organotin stabilizers where tin is bonded to sulfur, which is Compound A, claim 247. Ex. 9 at 1:45.

## **2. Level of Skill in the Art**

The level of skill in the art reflects the teachings in the prior art references themselves. A "person of ordinary skill in the art" is a "hypothetical person who is presumed to know the relevant prior art." In re GPAC, Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995). Thus, "the level of ordinary skill in the art . . . [is] best determined by appeal to the references of record." GPAC, 57 F.3d at 1579; see In re Oelrich, 579 F.2d 86, 91 (CCPA 1978) ("[T]he PTO usually must evaluate . . . the level of ordinary skill solely on the cold words of the literature."). The Board in this case properly relied on the prior art as indicia of one skilled in the art. Ex. 1 at 13-14. The Board was correct in its determination and Atochem did not dispute this finding before the Board.

**3. The Differences Between the Prior Art and the Claimed Invention**

**a. The Prior Art References Teach Each Element of the Claimed Invention, and the Only Difference Is That the Compounds Are Not Taught in a Single Reference**

The following claim chart shows that each part of Atochem's claimed composition is set forth in one or more of the prior art references. (Kauder (Ex. 8) and Weinberg (Ex. 7) provide further disclosures of claim elements shown in the references listed in the claim chart. Ex. 8 at 2:38-64; Ex. 7 at 1:25-37. Therefore, they are not separately listed in the claim chart.)

Representative Claims 247 and 296 (Def. Ex. 1 at 2)	Gough (Def. Ex. 3)	Stapfer (Def. Ex. 4)	Hechenbleikner '527 (Def. Ex. 5)	Wowk (Def. Ex. 9)	Schroeder (Def. Ex. 10)
Composition comprising a product by mixing in amounts effective to stabilize vinyl halide resins	Synergistic stabilizer compositions that improve resistance to early color formation in vinyl halide resins. (Gough at 1:7-19.)	Stabilizer compositions for halogen-containing resins. (Stapfer at 1:18-20.)	Compositions to stabilize vinyl halide resins ('527 at 1:11-13.)	Compositions to stabilize vinyl halide resins against deteriorative effects of heat and light. (Wowk at 1:38-41.)	Compositions to stabilize PVC (Schroeder at 1:17-22.)
(i) a mono- or diorganotin compound wherein at least one bond to tin is sulfur; and (Compound A, Claim 247)		Numerous organotin mercaptides where at least one bond to tin is sulfur are disclosed. (Stapfer at 1:4-32.)	organotin mercaptides where at least one bond to tin is sulfur, that is, $R_3SnS$ . ('527 2:38-29.)	organotin mercaptides where at least one bond to tin is sulfur (Wowk at 1:42-49.)	organotin mercaptides where at least one bond to tin is sulfur (Schroeder at 1:64-70.)
(i) a mono- or diorganotin compound wherein at least one bond to tin is a halogen; and (Compound A', Claim 296)				organotin halide compounds where at least one bond to tin is halogen (Wowk at 1:42-49.) An exhaustive list of such compounds is also given. (Wowk at 2:28-67.)	organotin halides where at least one bond to tin is halogen, in this case fluorine (Schroeder at 1:64-70.)
(ii) a mercapto alkanol ester of a monocarboxylic acid. (Compound B)	Organic sulfur compounds, specifically compound (g) where $h=1$ and $j=0$ , that is, 2-thioethyl octanoate, which is a mercapto alkanol ester of a monocarboxylic acid. (Gough at 3:65-4:11; 8:40-45; and 8:64.)				

As explained above, Gough discloses Compound B. Gough also teaches that synergistic combinations of organic sulfur compounds and organotin compounds are known PVC stabilizers. Ex. 3 at 1:67-2:10. Despite the fact that Gough generally discloses organotin compounds, including organotin borate (Ex. 3 at 1:7-9), Gough does not teach an organotin stabilizer compound that has at least one atom of sulfur bonded to tin (Compound A) or an organotin compound that has at least one halogen atom bonded to tin (Compound A'). A person of ordinary skill in the art would expect that Gough's Compound B would be useful in combination with other organotin compounds because it is useful with Gough's organotin borate, which is part of the same class as the claimed organotin compounds. See Ex. 1 at 14-15.

For claim 247, the element missing from Gough is taught in Stapfer, Hechenbleikner '527, Kauder, Weinberg, Wowk, and Schroeder. Exs. 4-5, 7-10. As explained above, each of these references describes an organotin stabilizer compound that has at least one atom of sulfur bonded to tin, that is, Compound A. Ex. 4 at 11:4-32; Ex. 5 at 2:38-39; Ex. 8 at 1:34-38; Ex. 7 at 1:38-50, Ex. 9 at 1:42-49; and Ex. 10 at 1:64-70.

For claim 296, the element not shown in Gough, Compound A', is taught by Wowk and Schroeder. Exs. 9-10. As explained above, these references describe an organotin stabilizer compound that has at least one atom of a halogen bonded to tin, that is, Compound A'. Ex. 9 at 1:38-51; Ex. 10 at 1:64-71; see Ex. 13 at 3. They also teach an organotin stabilizer compound that has at least one atom of sulfur bonded to tin, that is, Compound A. Ex. 9 at 1:42-49; Ex. 10 at 1:64-70.

**b. Substantial Evidence Supports the Board's Factual Finding That There Is Ample Motivation To Combine the Prior Art References to Render the '759 Application Obvious**

Because each of the pieces of the claimed invention can be found in the prior art (Compounds A, A', and B), the next question is whether there is a motivation to combine the references to render the claims of the '759 application obvious. Motivation is a question of fact. See Gartside, 2000 WL 156565, at \*13. Therefore, the Board's finding of motivation in this case can only be reversed if not supported by substantial evidence. See id.

When an obviousness determination is based on multiple prior art references, as here, there must be a showing of some teaching, suggestion, or reason to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997). Evidence of suggestion, teaching, or motivation to combine prior art references may come from, among other places, the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Although the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must be clear and particular. See Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472 (Fed. Cir. 1997); Dembiczak, 175 F.3d at 999.

The Board found that there was motivation to combine the prior art references:

However, Gough's stabilizing composition comprises an organotin borate rather than the presently claimed organotin compounds wherein the tin is bonded to at least one halogen or sulfur [Compounds A and A']. This lack of disclosure in Gough does not, in our view, negate the conclusion of obviousness reached by the examiner. Based on the collective teachings of Gough, including the discussion in the BACKGROUND section that it was known in the art to employ synergistic combinations of organic thiols and organotin mercaptides as stabilizers for vinyl



halide polymers, and the applied secondary references, we fully agree with the examiner that one of ordinary skill in the art would have found it prima facie obvious to utilize a combination of a mercapto alkanol ester of a monocarboxylic acid [Compound B] and organotin compounds [Compounds A and A'] within the scope of the appealed claims as a stabilizer for a vinyl halide resin.

Ex. 1 at 13-14. The Board further determined that one of ordinary skill in the art would have been motivated to substitute for the organotin borate of Gough other organotin compounds well-known in the art. Specifically, the Board held:

It is our view that one of ordinary skill in the art would have understood that the synergistic combination of Gough is superior to other known combinations of stabilizers, and that other combinations of organotin compounds and a mercapto alkanol ester of a monocarboxylic acid are effective, if not equivalent, stabilizers for vinyl halide resins.

Ex. 1 at 14-15.

The motivation to combine Gough with the secondary references comes from both the references themselves and the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999. All of the prior art references are directed to the same problem, the stabilization of PVC. See claim chart above; Ex. 6 at 1:14-19; Ex. 7 at 1:38-51; Ex. 8 at 1:43-47. All of the prior art references disclose the use of organotin compounds, alone or in combination with another compound to stabilize PVC. Ex. 3 at 1:7-14; Ex. 4 at 1:17-20 and 11:5-33; Ex. 5 at 1:11-13 and 2:27-40; Ex. 6 at 1:14-27; Ex. 7 at 1:14-37; Ex. 8 at 1:16-25; Ex. 9 at 1:6-8; Ex. 10 at 1:18-23. These facts alone provide ample motivation to combine the prior art to render the '759 application claims obvious.

Additional motivation is found in Gough. Gough states that synergistic combinations of organic sulfur compounds and organotin compounds where tin is bonded to sulfur are known in

the art. Ex. 3 at 1:46-59. This provides a suggestion to combine the specific organic sulfur compound disclosed in Gough, a mercapto alkanol ester of a monocarboxylic acid (Compound B) with the specific organotin compound in which tin is bonded to sulfur recited in claim 247 (Compound A) and disclosed in Stapfer, Hechenbleikner '527, Weinberg, Kauder, Wowk, and Schroeder. See Ex. 1 at 14-15; Ex. 13 at 2-3. This also provides the motivation to combine the specific organic sulfur compound disclosed in Gough, a mercapto alkanol ester of a monocarboxylic acid (Compound B) with the specific organotin compound in which tin is bonded to a halogen recited in claim 296 (Compound A') disclosed in Wowk and Schroeder. See Ex. 13 at 3.

Stapfer provides a further motivation to combine the references. It states "[w]hile many of the compounds listed are poor stabilizers alone, they may be used in combinations which exhibit synergism that are further improved by the present invention." Ex. 4 at 3:16-19. One of the classes of disclosed compounds are organotin compounds where tin is bonded to sulfur, or Compound A. Ex. 4 at 11:4-32. Another class of compounds disclosed are organic sulfur compounds similar to the compound in Gough (Compound B). Ex. 4 at 11:35-61. This statement in Stapfer provides a clear motivation to combine references disclosing Compound A with those describing Compound B to make a superior composition for stabilizing PVC. See Ex. 1 at 14; Ex. 13 at 3.

Therefore, as the Board found, these teachings in Gough and Stapfer that improved PVC stabilizers are obtained by combining organic sulfur compounds with organotin compounds provide ample motivation to use the mercapto alkanol ester taught by Gough in combination with

the organotin compounds taught by the secondary references. Ex. 1 at 13-15. The Board's finding of motivation to combine is supported by substantial evidence.

**4. Substantial Evidence Supports the Board's Finding that Atochem's Objective Evidence of Nonobviousness Does Not Overcome the Prima Facie Obviousness of Atochem's Claimed Composition**

A patent applicant may rebut the PTO's prima facie case of obviousness by presenting objective evidence of nonobviousness to the PTO. Beattie, 974 F.2d at 1313. The patent applicant must establish a nexus between the scope of the claims and the objective evidence presented, however, in order for the evidence to be given weight. See GPAC, 57 F.3d at 1580-81 (The PTO committed "no clear error in [its] attribution of little weight to [the patentee's] objective evidence of nonobviousness and no legal error in [its] ultimate finding that the overall weight of such evidence does not outweigh the evidence of obviousness relied upon by the examiner.").

Before the PTO, Atochem relied on the Fouré declaration (Def. Ex. 14), executed August 18, 1982, as evidence of the allegedly unexpected superiority of Atochem's claimed composition over the prior art. See Ex. 14 ¶ 5. Atochem, however, failed to explain the content and significance of the Fouré declaration data. See Ex. 1 at 15. Indeed, Atochem's only reference to Fouré in its argument concerning obviousness in its appeal brief was the conclusory statement that Fouré "provides a number of comparisons of compositions of the present invention with those of Gough and Stapfer. There is more than a single comparison." Ex. 11 at 35. Such vague and general statements "amount[] essentially to mere pleading, unsupported by proof or a showing of facts." In re Borkowski, 505 F.2d 713, 718 (CCPA 1974).

Moreover, as the Board found, the Foure declaration also fails to provide an adequate comparison to the closest prior art. Ex. 1 at 15-16. What is the closest prior art is a question of fact. In re Johnson, 747 F.2d 1456, 1460 (Fed. Cir. 1984). The Board found that Gough was the closest prior art because it disclosed a mercapto alkanol ester (Compound B) in combination with organotin borate, an organotin compound similar to Compounds A and A'. Ex. 1 at 16. This finding is supported by the substantial evidence of Gough's teachings discussed above. The Board also found that the Foure declaration does not provide an adequate comparison to this closest prior art. Ex. 1 at 15-16. In particular, the declaration fails to compare Atochem's claimed composition with Gough's closest composition, the combination of Compound B and an organotin borate. See Ex. 14 (Foure Decl.) (listing Gough compounds used by Foure; Compound B, which Gough refers to as compound (g) (see Ex. 3 at 3:49-4:12), is not included). Foure's data does not show that Atochem's claimed composition is superior to the closest prior art.

The Board also found that Foure's data is not commensurate in scope with the degree of protection sought by the appealed claims. Ex. 1 at 16; see In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983). Compounds A, A', and B each represent a group of particular chemicals. See, e.g., Ex. 9 at 2:28-68 (listing examples of Compound A). The Board found that Foure's data represents such a small fraction of these chemicals that there is no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition. Ex. 1 at 15-16; see In re Lindner, 457 F.2d 506, 509 (CCPA 1972). In fact, Foure only used five examples of the claimed composition in performing his analysis. Ex. 14 ¶ 4 (listing only five mercaptoesters from Atochem's application, which the Foure declaration refers to as the Chenard application after the first named inventor).

The Board's treatment of the Fouré declaration is supported by substantial evidence. The Fouré declaration neither presents a comparison to the closest prior art nor is its narrow evidence commensurate with the scope of the broad '759 application claims. Fouré does not present sufficient evidence of nonobviousness to overcome the prima facie obviousness of Atochem's claimed composition.

**V. ATOCHEM IS NOT ENTITLED TO PRESENT NEW EVIDENCE TO THIS COURT WHICH IT DID NOT FIRST PRESENT TO THE PTO**

A plaintiff in a section 145 action can, under the proper circumstances, present new evidence not first presented to the PTO. E.g., Winner Int'l Royalty Corp. v. Wang, \_\_\_ F.3d \_\_\_, 2000 WL 66374, at \*5 (Fed. Cir. Jan. 27, 2000) (attached as Ex. 18). However, Atochem is wrong to assert that it has a right to present new evidence. See Joint Report Under LcvR 16.3(d) ¶ (1)(b)(i). A section 145 plaintiff must justify why this Court should consider the new evidence in the first instance. "[T]he applicant does not start over to prosecute his application before the district court unfettered by what happened in the PTO." Fregeau, 776 F.2d at 1038. This Court has noted the "policy of encouraging full disclosure to administrative tribunals is a compelling reason for Article III courts to fashion limitations on the admissibility of supplementary evidence" in actions under 35 U.S.C. § 145. MacKay v. Quigg, 641 F. Supp. 567, 570 (D.D.C. 1986) (emphasis in original); see also DeSeversky v. Brenner, 424 F.2d 857, 858-59 (D.C. Cir. 1970) (plaintiff precluded from presenting new issues at least in the absence of some reason of justice put forward for failure to present the issue to the Patent Office, "since the application of Patent Office expertise in the first instance may either obviate the need for judicial consideration, or illuminate the issues and facilitate the court's disposition."); Holloway v. Quigg,

9 U.S.P.Q.2d 1751, 1752 (D.D.C. 1988) (new evidence excluded where plaintiff did not demonstrate his failure to raise issues at the PTO was neither intentional nor negligent).

Atochem filed its first application concerning the claimed composition in 1979, Compl. ¶ 7, and Atochem did not file its appeal to the Board until 1994. Ex. 11 at 36. Thus, Atochem had fifteen years to submit all relevant evidence for the PTO's patent examiner to consider before it filed its appeal. See DeSeversky, 424 F.2d at 858-59. In particular, Fouré executed the declaration on which Atochem relied before the Board in 1982. Ex. 14. Atochem had twelve years between the execution of the declaration and the filing of its appeal brief to gather any additional evidence of nonobviousness. Atochem failed to do so.

Moreover, even after Atochem filed its appeal to the Board in 1994, Atochem was still free to present new evidence. For example, Atochem could have petitioned to present the new evidence in connection with the present application even while it was pending before the Board. An applicant can file an evidentiary declaration after the application has been forwarded to the Board (but before a decision thereon by the Board) if the applicant provides good and sufficient reason why it did not present the evidence earlier. See 37 C.F.R. § 1.195. The application is remanded to the examiner for further prosecution in view of the new evidence.

Even if the PTO decided that Atochem had not shown good cause and rejected Atochem's petition to present the new evidence in connection with the present application, Atochem was still free to file another application (called a "continuation") at any time. 35 U.S.C. § 120. The only requirements for a continuation application are that the claimed invention and inventors be the same, and that the continuation be filed while the earlier application is still pending. Id. Therefore, Atochem could have filed a continuation application any time before or during the

pendency of its appeal to the Board -- and presented the new evidence of nonobviousness in that application.

In fact, Atochem did file a continuation application in 1995, just before the change in the patent term statute which Atochem refers to in its complaint. Ex. 15; see Compl. ¶ 14. Atochem could have used that application as a vehicle to present new evidence. For example, Atochem could have submitted new evidence in that application to overcome the examiner's obviousness rejections. Then, if the examiner was convinced by the evidence, Atochem could have obtained a patent on the continuation application. But Atochem abandoned its continuation application in 1996 when it failed to continue prosecution of the application. Ex. 16. (Atochem abandoned the application at the stage where Atochem would have had to pursue an appeal to Board. Ex. 16.) As explained above, however, Atochem could still have sought to provide new evidence in the continuation application, as in the present application, even while it was pending before the Board. Atochem failed to do so.

Thus, Atochem is wrong to allege that the 1995 change in the patent term statute and the fact that the Board issued its decision in 1999 excuse its failure to present new evidence to the PTO. Compl. ¶¶ 14-15. Atochem could have presented new evidence before the change in the law. Moreover, Atochem could have preserved its pre-change continuation application as a vehicle to attempt to present new evidence even after the change. Atochem is responsible for its decisions not to present new evidence and not to preserve the continuation application.

Finally, to allow Atochem to introduce new evidence now, over twenty years after filing its first patent application, would be a waste of judicial resources because "the application of Patent Office expertise in the first instance may either obviate the need for judicial consideration,

or illuminate the issues and facilitate the court's disposition." DeSeversky, 424 F.2d at 858-59.


Absent good reason provided by the applicant, the PTO should consider all the evidence first.


That way, the PTO can apply its expertise to all the evidence and provide the Court with a basis for review. The Court should not be the first tribunal to review technical evidence.

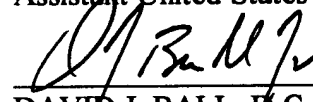
**V. CONCLUSION**

This Court should affirm the Board's decision that Atochem's claimed composition is unpatentable; refuse to allow Atochem to present new evidence that it did not present to the PTO; and enter judgment that Atochem is not entitled to a patent.

Respectfully submitted,

  
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